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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/212,556 12/16/98 KURAKATA

S 980689/HG

EXAMINER

HM12/0410

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OWENS JR, H

ART UNIT

PAPER NUMBER

1623

DATE MAILED:

04/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/212,556

Applicant(s)
Kurakata et al.

Examiner
Howard Owens

Group Art Unit
1623



☒ Responsive to communication(s) filed on Jan 26, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-67 is/are pending in the application.

Of the above, claim(s) 15-28 and 42-67 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-14 and 29-41 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3-6, 8, 13

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Election/Restriction

Claims 15-28 and 42-67 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 12.

Applicant's election with traverse of species I in Paper No. 12 is acknowledged. The traversal is on the ground(s) that "it is not a species requirement of the type set forth in the third paragraph of MPEP 803.02". This is not found persuasive because as cited in the third paragraph of MPEP 803.02 -in applications containing claims wherein independent and distinct inventions are set forth in Markush-type claims, the examiner may require a provisional election of species prior to examination on the merits. Independent and distinct are defined as two or more of the members being so unrelated and diverse that a prior art reference would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In the instant case, the non-

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elected species clearly constitute distinct structures from those of species I, varying from tricyclic sulfaminos to biphenyl ethers, wherein although the method of treatment is the same, the divergent structures could not render the claims of species 1 obvious.

The requirement is still deemed proper and is therefore made FINAL.

This application contains claims drawn to an invention nonelected with traverse in Paper No. 12. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

35 U.S.C. 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-14 and 29-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura et al., EP 0799823 A1 and Strelkov et al., American Journal of Physiology, vol. 257, C261-C269.

Kimura et al., teach the analogous diphenylpyrrole compounds of species 1 of the instant invention. Kimura et al. teach that these compounds as cyclooxygenase-2 inhibitors inhibit prostaglandins. Kimura et al. however does not teach the usefulness of these compounds to treat cachexia or disorders resulting from tumors.

Strelkov et al. teach that the inhibition of prostaglandin production counters tumor related cachexia or muscle wasting and other deleterious side effects of tumors (p. C267), which adequately bridges the nexus between the differences in the prior art and the invention as claimed.

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It would have been prima facie obvious to a person of ordinary skill in the art at the time the invention was made to use the diphenylpyrrole compounds of the instant invention to treat cachexia or side effects of tumor related disorders.

A person of ordinary skill in the art would have been motivated to use these art recognized prostaglandin inhibiting diphenylpyrrole compounds to treat cachexia or side effects of tumor related disorders because the prior art has established the usefulness of prostaglandin inhibitors in countering the side effects of tumors such as muscle wasting or cachexia.

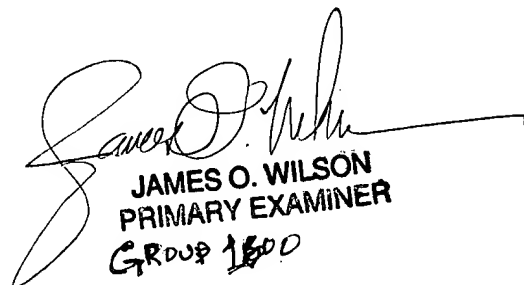
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Howard Owens whose telephone number is (703) 306-4538. The examiner can normally be reached on Tuesday-Friday 9 a.m.-6:30 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, Mr. Gary Geist (703) 308-1701, may be contacted. The fax phone number for Group 1600, Art Unit 1623 is (703) 308-4556 or 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-1235.

Visit the U.S. PTO's site on the World Wide Web at <http://www.uspto.gov>. This site contains lots of valuable information including the latest PTO fees, downloadable forms, basic search capabilities and much more!

Secure and confidential access to patent application status is now available; see <http://www.uspto.gov/ebc/index.html> for more information.


JAMES O. WILSON
PRIMARY EXAMINER
GROUP 1600